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UNITED STATES DEPARTMENT OF COMMERCE
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In re Application of:	:	
Wrigley et al.	:	DECISION ON
Application No.: 09/284806	:	
PCT No.: PCT/GB97/02907	:	PETITION UNDER
Int. Filing Date: 21 October 1997	:	
Priority Date: 21 October 1996	:	37 CFR 1.181, 1.137(a)
Attorney's Docket No.:117-284	:	
For: Cytokine Production Inhibitors	:	AND 1.137(b)

This is in response to the petition filed on 05 June 2000.

BACKGROUND

On 21 October 1997, applicant filed international application number PCT/GB97/02907, which designated the United States and claimed a priority date of 21 October 1996. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 30 April 1998. A Demand electing the United States was filed on 18 May 1998, which was prior to the elapse of 19 months from the priority date. Consequently, the period for payment of the basic national fee in the United States expired as of midnight on 21 April 1999.

On 21 April 1999, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee and a surcharge under 37 CFR 1.492(e).

09 June 1999, a "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) was transmitted to applicant, requiring the timely submission of an oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) in order to avoid abandonment of the application with respect to the United States.

On 06 January 2000, the DO/EO/US transmitted a Notification of Abandonment to applicant, indicating that the application was abandoned as to the United States for failure to timely respond to the requirements of the Form PCT/DO/EO/905 mailed on 09 June 1999.

Applicants filed the instant petition on 05 June 2000.

DISCUSSION

Petition to Withdraw Holding of Abandonment

The petition requests that the holding of abandonment be withdrawn on the basis that the Form PCT/DO/EO/905 of 9 June 1999 allegedly was never received. This petition is treated under 37 CFR 1.181.

As explained in MPEP 711.03(c), and following *Delgar v. Schuyler*, 172 USPQ 513 (D.D.C. 1971), an adequate showing of non-receipt of papers mailed to applicant by the Office must include (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket records must also be referenced in petitioner's statement). A review of the totality of evidence now of record establishes that, within the practice under MPEP 711.03(c), petitioner has satisfied requirement (1), but has not satisfied requirements (2) and (3).

Regarding requirement (1), the petition includes an appropriate statement.

Regarding requirement (2), the petition includes a statement that "Attorneys for Applicants investigated the fileroom and mailroom records to determine whether Nixon & Vanderhaye, P.C. had ever received the Missing Requirement Notification." It is not clear that the alleged investigation of the "fileroom and mailroom records" specifically included the required "search of the file jacket and docket records". As such, it would be inappropriate to conclude on the basis of the present record that requirement (2) has been satisfied.

Regarding requirement (3), the petition is not accompanied by any relevant docket records.

For the reasons explained *supra*, it would be inappropriate to conclude that the instant petition provides a showing sufficient to grant the requested relief on the basis of alleged non-receipt of the Notification of Missing Requirements.

Petition Under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for

the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); *In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. *Haines v. Quigg*, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Regarding requirement (1), the petition is accompanied by a declaration of the inventors, but the declaration is not acceptable because at least one sheet of the declaration is missing (there are two first sheets and two third sheets, but only one second sheet). Because at least one second sheet is missing, it is unclear whether each of the inventors signed a copy of the declaration which listed all of the other inventors. That is, it is possible that either some of the inventors signed a declaration that did not contain a second sheet, or that some of the inventors signed a declaration whose second sheet differed (e.g., from inadvertent errors) from the second sheet of record. Therefore, it would be inappropriate to accept the declaration of record.

Regarding requirement (2), the petition was accompanied by the required petition fee.

Regarding requirement (3), review of the records of the Office reveals no irregularity in the mailing of the Notification of Missing Requirements. In the absence of such irregularity, the burden is upon the party alleging non-receipt of the official correspondence to show that the entire delay in filing the required reply was unavoidable despite the exercise of the requisite diligence. In the instant petition, applicants' showing consists of conclusory statements to the effect that the Notification of Missing Requirements was not received, without any direct evidence (a) showing that the Notification was not received (as discussed *supra*) or (b) showing that the failure to respond occurred despite the exercise of the requisite

diligence on the part of petitioner. Specifically, petitioner has failed to show what measures were in place to ensure timely response to Office correspondence. Instead, the petition merely speculates that the failure to reply was the result of "either failure of the U.S. Patent and Trademark Office to duly mail the Missing Parts Notice [sic] or failure of the United States mail. The Attorneys for Applicants never received the Missing Requirement Notification when and if mailed" without providing any evidence germane to any of these possibilities. Thus, petitioner has not established that the delay in responding to the Notification of Missing Requirements was "unavoidable" within the meaning of 37 CFR 1.137(a).

Regarding requirement (4), no terminal disclaimer is required in this case because the international filing date of the instant application was after 08 June 1995.

For the reasons explained *supra*, it would be inappropriate to grant the petition under 37 CFR 1.137(a) on the basis of the present record.

Petition Under 37 CFR 1.137(b)

The petition alternatively requests consideration under 37 CFR 1.137(b). A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the petition is accompanied by a declaration of the inventors, but the declaration is not acceptable because at least one sheet of the declaration is missing (there are two first sheets and two third sheets, but only one second sheet). Because at least one second sheet is missing, it is unclear whether each of the inventors signed a copy of the declaration which listed all of the other inventors. That is, it is possible that either some of the inventors signed a declaration that did not contain a second sheet, or that some of the inventors signed a declaration whose second sheet differed (e.g., from inadvertent errors) from the second sheet of record. Therefore, it would be inappropriate to accept the declaration of record.

Regarding requirement (2), the petition was accompanied by the required petition fee.

Regarding requirement (3), the petition includes a statement that "the abandonment resulted from non-receipt of an office communication, and thus was unavoidable or unintentional." This statement is being construed as a statement that "the entire delay in filing *the required* reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required in this case because the international filing date of the instant application was after 08 June 1995.

For the reasons explained *supra*, it would be inappropriate to grant the petition under 37 CFR 1.137(b) on the basis of the present record.

DECISION

For the reasons explained above, the petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The petition under 37 CFR 1.137(a) is **DISMISSED** without prejudice.

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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